

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte: AMIR SAID

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Application No. 09/912,278

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MAILED  
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U.S. PATENT AND TRADEMARK OFFICE,  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received at the Board of Patent Appeals and Interferences on November 26, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

**EXAMINER'S ANSWER**

**New Grounds of Rejection**

On November 1, 2006, an Examiner's Answer was mailed. The Examiner's Answer includes a new ground of rejection, where Claims 5-8, 14-16 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manduca in view of Dhawah, as applied to claims 2, 12, and 25 above, and further in view of U.S. Patent 5,377,018.

A review of the application reveals that the Final Rejection mailed February 1, 2005, rejected claims 5-8 and 20-22 under 35 U.S.C. 103(a) as being unpatentable over Manduca in view of U.S. Patent 5,377,018 by Rafferty and Claims 14-16 under 35 U.S.C 103(a) as being

unpatentable over Manduca in view of Dhawan, as applied to claim 12 above in further view of Rafferty.

When a new ground of rejection is introduced in the Examiner's Answer, the Examiner is required to obtain approval of the Technology Center Director or his/her designee. Further, any new ground of rejection is required to be prominently identified, e.g., a separate heading with all capitalized letters. See MPEP § 1207.02(A)(6)(d).

To correct this problem, the examiner will need to vacate the Examiner's Answer mailed November 1, 2006, and mail a Supplemental Examiner's Answer with the approval of the Technology Center Director or designee.

#### **Evidence Relied Upon**

In the Examiner's Answer mailed November 1, 2006, the Examiner rejected claims 4 and 27 under 35 U.S.C 103(a) as being unpatentable over Manduca in view of Dhawan and Vaidyanathan, as applied to claims 3 and 26 above, and further in view of U.S. Patent 5,594,807 by Liu. It is noted that the Liu reference has not been listed in the Evidence Relied Upon section. In accordance with MPEP § 1207.02, the "Evidence Relied Upon" section should include:

(8) *Evidence Relied Upon*. A listing of the <\*\*>evidence< relied on >(e.g., patents, publications, admitted prior art)<, and, in the case of nonpatent references, the relevant page or pages.

#### **CONSIDERATION OF APPEAL BRIEF**

Appellant filed an Appeal Brief December 20, 2006, in response to the Notification of Non-Compliant Appeal Brief mailed November 20, 2006. There is no indication on the record that the above Appeal Brief has been acknowledged by the Examiner. A written communication

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notifying appellant of the Examiner's consideration of the above Appeal Brief is required.

**CONCLUSION**

Accordingly, it is

**ORDERED** that the application is returned to the Examiner to:

- 1) issue and mail a revised Examiner's Answer, clarifying and properly identifying any new grounds of rejection and correcting the Evidence Relied Upon section;
- 2) acknowledge and consider the Appeal Brief December filed 20, 2006; and
- 3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

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PJN/tsj

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